

REMARKS

STATUS OF CLAIMS:

Claims 1-7 are pending in the application. Claims 1-7 are rejected.

35 U.S.C. §112:

Claims 4-6 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite because the Examiner alleges that the element having the claimed “cross section” in claim 4 is unclear. In order to overcome this rejection, Applicant hereby amends the independent claims to further define the removing means and removing claw, which amendment cancels the recitation regarding the cross section. Accordingly, Applicant respectfully submits that this rejection is overcome and should be withdrawn.

CLAIM OBJECTIONS:

Claims 2 and 5 are objected to due to informalities because the Examiner asserts that the terms “mm” and “KPa” should be surrounded by parentheses instead of brackets. Accordingly, claims 2 and 5 are hereby amended to replace the brackets with parentheses. Applicant respectfully requests that the objection to claims 2 and 5 be withdrawn.

35 U.S.C. §103:

The Examiner rejects claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over Applicant’s Admitted Prior Art (“APA”) in view of Sone (U.S. Patent No. 4,447,054). Applicant respectfully traverses this rejection based on the following remarks.

Applicant hereby amends the claims to further define the removing means and removing claw. In particular, the amended claims define an upper face and side faces. The area joining the upper face and side faces is defined as being rounded.

The Examiner relies on the APA for an alleged teaching of a majority of the claimed features, and applies Sone for a teaching of a removing claw 1 having both ends of an upper side being rounded. The Examiner points to Figure 6b of Sone for alleged support of this feature. Figure 6b shows a peeling paw 1 that has an arrowhead-shaped end portion. The Examiner apparently asserts that one would have been motivated to provide such an arrowhead-shaped portion on the APA, for example, Figure 7(b) of the present specification.

To establish a *prima facie* case of obviousness, the Examiner must show that the prior art references, when combined, teach or suggest all of the claimed features. The combination of the APA and Sone fails to teach or suggest the claimed invention because the claims define a removing means or removing claw with an upper face and side faces. The upper face is defined as being operative to contact a recording medium. Also defined are rounded portions joining the upper face and respective side faces, which rounded portions extend along the length of the respective side faces.

At least the defined rounded portions are not taught or suggested by the combined references because, if the APA were provided with the arrowhead-like shape of Sone, rounded portions joining an upper face and side faces would not have been taught. Instead, one skilled in the art may have been taught to merely provide a pointed left end portion when looking at the top view shown in Figure 7(b) of the present specification, but not to round the area that joins the upper face and side faces. Also, the rounded portions of the present invention provide beneficial features for protecting the recording medium. Further, as a non-limiting example, the removing claw of the present invention not only acts to remove a toner sheet, but also guides the same in order to prevent recording smear or contamination due to toner particles, etc. The applied references do not provide these benefits to the same extent as the present invention.

Consequently, the combination of the APA and Sone would have failed to teach or suggest all of the claimed features, and the rejection of claims 1, 4 and 7 under 35 U.S.C. §103(a) should be withdrawn.

Dependent claims 2, 3, 5 and 6 also are patentable over the applied references, at least by virtue of their respective dependencies on independent claims 1 and 4.

Furthermore, in regard to claims 2 and 5, the Examiner submits that "it is obvious to modify a particular feature of a device to a specific degree according to the particular operation at hand." Although, the features of claims 2 and 5 are not taught or suggested at least due to their dependency, Applicant respectfully submits that the Examiner's assertion is not the test for

obviousness. In contradistinction, the mere fact that a reference can be modified does not make the resultant modification obvious unless the prior art also suggests the desirability of the modifications. See *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). None of the prior art references teaches or suggests having the claimed rounded feature with a curvature of $r = 1$ (mm) or more and an upper face of a tip with a face pressure of 1 (KPa) or less received from a recording medium being removed. Such features provide benefits that are neither taught nor suggested by the applied art.

In addition, it appears that the Examiner asserts that the features of claims 2 and 5 could have been obtained through experimentation. However, “[a] particular parameter must first be recognized as a result-effective variable...before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” MPEP §2144.05(b). The grounds of rejection do not address this threshold inquiry at all. Indeed, none of the art being relied upon appears to indicate that particular radius and face pressure parameters are recognized as having an effect. Moreover, the section of the MPEP cited by the Examiner (§2144.05(II)(A)) describes optimization of “concentration or temperature” - none of which are presently recited.

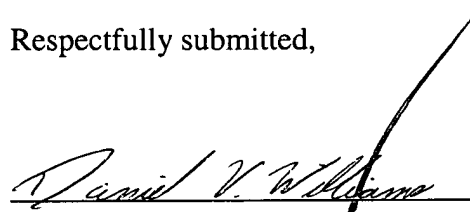
In view of the preceding amendments and remarks, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephonic interview, he is kindly requested to contact the undersigned attorney at the local telephone number listed below.

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. SERIAL NO. 09/758,203

ART UNIT 2854
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A Petition for Extension of Time with appropriate fee accompanies this document. The USPTO is directed and authorized to charge all additional required fees (except the Issue Fee and/or the Publication Fee) to our Deposit Account No. 19-4880. Please also credit any overpayment to said Deposit Account.

Respectfully submitted,



Daniel V. Williams
Registration No. 45,221

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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